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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,699	05/15/2006	Alexander Grinberg	37388-405600	8167
27717 7590 09/04/2008 SEYFARTH SHAW LLP 131 S. DEARBORN ST., SUITE 2400 CHICAGO, IL 60603-5803				
EXAMINER				
TRAN, THUAN Q				
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3693				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/561,699

**Applicant(s)**

GRINBERG ET AL.

**Examiner**

Thuan Tran

**Art Unit**

3693

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☒ Claim(s) 17, 22 and 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/003)  
Paper No(s)/Mail Date 4-3-2008 and 4-28-2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the US application filed on 12-22-2005.
2. Claims 4, 5, 7, 9-12, 15, 17, 18, 24, 26-28, 31-33, 35, 38, 39, and 42-44 have been amended.
3. Claims 17, 22, and 33 have been objected to.
4. Claims 1-45 are currently pending and have been examined.

### **Priority**

5. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

### **Information Disclosure Statement**

6. The Information Disclosure Statements filed on 4-3-2008 and 4-28-2006 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

### ***Claim Objections***

7. Claims 17, 22, and 33 are objected to because of the following informalities:

Amendments to a claim must be made by rewriting the entire claim with all changes (*e.g.*, additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an

existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered). MPEP Sec. 1.121(c). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-32 and 40-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). The preamble of the claims states, "A method," however this is not sufficient to tie the process claim to a particular apparatus in another statutory class. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the

subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claim 36, 39, 40, 43, 44, and 45** are rejected under 35 U.S.C. 102(b) as being anticipated by Swain, WO 02/25604.

11. **As per claims 36 and 40** Swain teaches:

- A system for facilitating on-line payment, the system comprising, art interface means which is arranged to be initiated via a system message (the message is the communications) and is arranged to provide connection to a payment means to enable processing of the payment (see at least page 7 line 12-20).

12. **As per claims 44 and 45** Swain teaches:

- An operating system (inherently the computer runs on an operating system) that has a computer readable medium (inherently computers have some type of medium for it to store and read information) that provides a computer program instructions to a computer (inherently, computers take instructions from a

computer readable medium to perform commands form a user, see at least page 2 line 10-11).

13. **As per claims 39 and 43** Swain teaches:

- wherein the payment means is a connection to a financial institution application for facilitating payment (see at least page 6 line 21-22).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 1-35, 37, and 41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Swain, WO 02/25604.

16. **As per claims 1 and 19:**

Swain teaches:

- an interface means which is arranged to be initiated via a merchant site and is arranged to provide a connection to a financial institution application to enable processing of the payment, via the financial institution application, to a merchant account, (see at least page 7 line 12-20).

Although Swain teaches a system for facilitating online payment for an online product transaction, he does not teach the details of a security means. However, in another embodiment described in Swain, he teaches:

- the financial institution application requiring a security means to enable processing of the payment, the connection being implemented to enable the security means to be obtained via a customer computing system (see at least page 2 line 16-17)

Together these two embodiments of Swain teach a system for facilitating online payment for an online product transaction using a security means. It would have been obvious to one of ordinary skill in the art at the time of the invention to produce this system with motivation to provide security to online transactions, thus, reducing loss due to fraudulent transactions.

17. **As per claims 2 and 20** Swain further teaches:

- wherein the interface means is arranged to enable the payment to proceed in real time (see at least page 1 line 10-18, shows a traditional merchant transaction proceeding in real time).

18. **As per claims 3 and 21** Swain further teaches:

- wherein the interface means is arranged to enable the payment to occur during the product transaction (see at least page 7 line 12-20).

19. **As per claims 4** Swain further teaches:

- wherein the interface means is arranged to be initiated by way of a customer computing system accessing the merchant site (see at least page 7 line 12-13).

20. **As per claims 5 and 22** Swain further teaches:

- wherein the interface means is arranged to generate confirmation to a merchant system that payment has occurred (see at least page 7 line 18-19).

21. **As per claims 6 and 23** Swain further teaches:

- wherein the system is arranged to provide a secure connection between the financial institution application (see at least page 10 line 22-23) and the merchant system for generation of confirmation that payment has occurred (see at least page 8 line 26-28).

22. **As per claims 7 and 24** Swain further teaches:

- the interface means being arranged to obtain transaction details and provide the details to the financial institution application to facilitate payment (see at least page 7 line 12-20).

23. **As per claims 8 and 25** Swain further teaches:

- wherein the transaction details include the payment amount (see at least page 7 line 12-20, the payment amount is required for the MWS to process the payment



transaction, therefore, payment amount is inherently in the "details of the payment transaction").

24. **As per claims 9 and 26** Swain further teaches:

- wherein the transaction details include a merchant account identifier (see at least page 7 line 12-20, some type of merchant account identifier is required for the MWS to process the payment transaction, therefore, the merchant account identifier is inherently in the "details of the payment transaction").

25. **As per claims 10** Swain further teaches:

- wherein the financial institution application is a known pre-existing financial institution application (see at least page 6 line 21-22, the issuing bank).

26. **As per claims 11 and 27** Swain further teaches:

- wherein the security means is obtained by enabling the customer to enter the security means via the customer computing system (see at least page 2 line 16-17).

27. **As per claims 12 and 28** Swain further teaches:

- wherein the security means is stored in a storage location accessible via the customer computing system, and the security means are obtained from the storage location via the customer computing system (see at least page 12 line

11-24 and page 2 line 16-17, the user enters the username and password into the computer, the computer then, inherently, stores the information in some temporary storage means such as RAM before sending it over the internet).

28. **As per claims 13 and 29** Swain further teaches:

- wherein the security means is stored in encrypted form, and wherein the interface means is arranged to decrypt the encrypted security means (see at least page 12 line 11-24 and page 10 line 12-14, when security means is ready to be sent over the internet through the SSL, it is encrypted. Then it is, inherently, stored in some temporary storage means such as RAM before sending it over the internet)

29. **As per claims 14 and 30** Swain further teaches:

- the system including storage means for storing decryption keys for decrypting encrypted security means (see at least page 12 line 11-24).

30. **As per claims 15 and 31** Swain further teaches:

- further including a database arranged to store transaction details of transactions (see at least page 9 line 9-11).

31. **As per claims 16** Swain further teaches:

- wherein the database is arranged to be accessible by a merchant system to enable a merchant to obtain details of transactions that they are associated with (see at least page 9 line 9-11).

32. **As per claims 17** Swain further teaches:

- wherein the database is arranged to be accessible by customer computing systems to enable customers to obtain details of transactions that they are associated with (see at least page 9 line 16-19).

33. **As per claims 18 and 32** Swain further teaches:

- wherein the interface means is a software agent (see at least page 2 line 10-11).

34. **As per claims 33, 34, and 35** Swain further teaches:

An operating system (inherently the computer runs on an operating system) that has a computer readable medium (inherently computers have some type of medium for it to store and read information) that provides a computer program instructions to a computer (inherently, computers take instructions from a computer readable medium to perform commands form a user, see at least page 2 line 10-11).

35. **As per claims 37 and 41:**

Swain teaches claims 36 and 40. He does not teach that the communications are in the form of e-mails. However, the examiner takes **Official Notice** that it is old and well

known in the finance arts to make communications in the form of e-mail messages. It would have been obvious to one of ordinary skill in the art at the time of the invention to communicate through e-mail messages to quickly communicate between parties.

36. **Claims 38 and 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Swain, WO 02/25604 in view of Mascavage, US 2003/0154164.

37. **As per claims 38 and 42:**

Swain teaches claims 36 and 40 as described above. He does not teach that the message includes a link to a payment means. However, Mascavage teaches:

- Wherein the system message includes a link to enable connection to the payment means (see at least paragraph 0057).

Together Swain and Mascavage teach an online payment system that includes a message that has a link to a payment means. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine these two with motivation to enable fast and reliable person to person electronic payments.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuan Tran whose telephone number is 571-270-1832. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/  
Supervisory Patent Examiner, Art Unit 3693

Thuan Tran  
Patent Examiner  
8-25-2008